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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/210,539 12/14/98 ISHIBASHI

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EXAMINER

IM22/0816
FINNEGAN, HENDERSON, FARABOW, GARRETT &
1300 I STREET, N.W.
WASHINGTON DC 20005-3315

EGWIM, K ART UNIT	PAPER NUMBER
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1713
DATE MAILED:

08/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/210,539

Applicant(s)

ISHIBASHI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2, 5, 6, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., for reasons cited in previous Office actions.
3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., each independently as applied to claims 1, 2, 5, 6, 8 and 10-12 above, and further in view of Yamada et al., for reasons cited in previous Office actions.

Response to Arguments

4. Applicant's arguments filed 7/2/01 have been fully considered but they are not persuasive.
5. In response to applicant's arguments that none of the references disclose or suggest a fastening component made from the biodegradable resins, in col. 9, line 32,

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Obuchi et al. teach that tying material are amount the articles that may be molded form the resin.

Further, in col. 12, lines 17-26, Tsai et al. teaches that the multi-component bio-fibers exhibit good mechanical strength properties such as break properties, such that they maintain their integrity during product use. Tsai et al. also teaches improved moldability and strength over prior biodegradable resins such as solely PLA.

Therefore, it is reasonable that the resin of Tsai et al. would have also been usable in a fastener, since the resin composition is essentially the same as the claimed composition. In re Zierden (162 USPQ 102).

6. As stated in prior actions regarding Applicant's arguments that prior art is silent about the diameter of the dispersed PLA components, the particle diameters claimed by applicant would have been within the range of particle diameters for the dispersed PLA of the prior art given that the compositional ranges and the processes used in preparing the prior art articles, which result in the given particle diameters, overlap in scope with that of the present invention. As such, the composition of the prior art is essentially the same as the claimed composition.

7. Regarding the composition of Bionolle 1020, applicant refers to a "TECHNICAL DATA SHEET" which was to be enclosed. However the Examiner has not received said data sheet. It is still asserted the Applicant makes it clear in the original specifications that "Bionolle 1020", the grade of Bionolle presently used, comprises 30%

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talc. In page 36, lines 17-23 and col. 37, lines 3-7 of the present specifications, Applicant explicitly defines Bionolle 1020 as "commercially available" **"talc-containing (30%) grade of the aliphatic polyester type biodegradable resin** made by Showa Highpolymer Co., Ltd and **sold under the trademark designation of 'Bionolle' #1020"**. As such, the composition of Tsai et al. is essentially the same as the claimed composition.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

KCE

KCE
August 14, 2001



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700